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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,604	09/16/2003	Gary Wayne Hamilton	AB190/99001	3612

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EXAMINER
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LEE, JONG SUK

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/664,604

Applicant(s)

HAMILTON ET AL.

Examiner

Jong-Suk (James) Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

1. The preliminary amendment filed on April 9, 2004 has been entered.

#### ***Information Disclosure Statement***

2. The information disclosure statement filed April 9, 2004 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

#### ***Claim Objections***

3. Claims 1, 2 and 4 are objected to because of the following informalities:  
  
Claim 1, line 1: "Apparatus" should be -- An apparatus -- or -- An auger apparatus --.  
  
Claim 1, line 4: "the same" should be -- the drive shaft --.  
  
Claim 1, line 7: "the wall" should be -- the side wall --.

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Claim 2, line 6: "the wall" should be -- the side wall --.

Claim 4, line 2: "the same" should be -- the drive shaft --.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 4: The limitation, "means at one end of said drive shaft for connecting..... and terminating in a free outer end spaced a selected distance from the end of said shaft opposite said one end" in lines 2-4 renders the claim indefinite because the orientation for the drive shaft is not clear as to whether "the free outer end" is the end to the power driven unit or not.

Re claim 29: The limitation, "said pilot drill shaft" in line 2 lacks clear antecedent basis.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

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basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-6, 9-11, 16, 20-24, 26-29, 32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Morse (US 4,077,737).

The preamble limitation, "A flight rock auger for removing plugs of hard material from post holes" is intended use and patentable weight is not given to the preamble.

Morse discloses a core drill comprising of: a cylindrical hollow cutting head comprising a hollow cylindrical body (25) defining side walls connecting a top end defining an upper peripheral edge and a lower open end defining a lower peripheral cutting edge including a plurality of teeth (28) extending from the lower peripheral edge; the top end of the hollow cylindrical body (7) including at least one support member (15) extending across at least a portion of the top end joining the side walls, the support member having at least one opening; a shaft/shank (32) having a diameter less than the cutting head, the shaft (32) including a proximal end connecting to the at least one support member (15) and having an opposing distal end extending therefrom; and a pilot/center drill (8) extending from the shaft (32) disposed within the cylindrical hollow cutting head and extending in axial alignment with the shaft, wherein at least a portion of a tip of the pilot drill extends pass the teeth extending from the lower peripheral edge of the cutting head, means for connecting (34, 35) the distal end of the shaft to a drive shaft of a power unit; the hollow cylindrical body including a cutaway portion/openings (25) on the side wall and extending around the periphery thereof a selected length forming a side wall edge

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extending along the cutaway portion (see Figs. 1-2; col.4, lines 17-68; col.5; lines 1-68; col.6, lines 1-38).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103<sup>o</sup> and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 2, 18, 28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morse et al in view of Hill (US 2,021,184). The teachings of Morse et al have been discussed above.

However, Morse fails to disclose or fairly suggest a quick disconnect assembly as the means for connecting to a power unit. Hill discloses a drilling structure and a drill bit comprising of: a cylindrical hollow cutting head (35) defining a hollow cylindrical body having a top end and a lower open end including a plurality of teeth (41) extending from the lower peripheral edge, the teeth (41) angled forwardly and outwardly protruding pas the lower peripheral edge, the hollow cylindrical body having an upper section (37) and a lower section defining a greater

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exterior diameter than the upper section a; means (24) for cooperative engagement with a shaft/drill pipe section (10, 11) extending outwardly therefrom; a quick disconnect coupling (15), disposed upon the distal end of the shaft (10), including a female socket end for cooperative engagement with a male end of a drive shaft (13) of a motor; a support member (32) connecting the top end of the cylindrical body member with the shaft (11); a plurality of openings (44) on the top end of the cylindrical body for mud circulation; a core sample is taken through the bore (40) of the cutting bit (35) (see Figs.1-5; pg.2, right col. lines 30-75; entire pg.3).

Therefore, in view of Hill, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to add the quick disconnect coupling to the drive shaft of Morse in order to reduce the time of operation and cost.

### ***Obviousness-Type Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-17, 19-29, 32 and 33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,619,413.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is somewhat broader recitation of the '413 Patent, for example, in claim 22 of present claimed invention and claim 3 of '413 Patent, the Applicants claim:

“a cylindrical hollow cutting head comprising a hollow cylindrical body defining a tubular side wall connecting to an end plate extending across an upper peripheral edge of said hollow cylindrical body and a lower open end defining a lower peripheral cutting edge including a plurality of teeth extending from said lower peripheral edge; a drive shaft having a diameter less than said cutting head, said drive shaft including a proximal end connecting to said end plate and having an opposing distal drive end extending therefrom; and a pilot drill extending from an end plate, said pilot drill disposed within said cylindrical hollow cutting head and extending in axial alignment with said drive shaft; said pilot drill extending pass said teeth extending from said lower peripheral edge of said cutting head; and a cutaway portion of the body extending around the periphery thereof a selected length forming an opening and defining a side wall edge extending along a portion of said side wall from along a portion of the bottom above said teeth toward said end plate”;



Whereas in '413 Patent, the Applicants claim:

“a cylindrical hollow cutting head comprising a hollow cylindrical body defining a circular side wall connecting to an end plate extending across an upper peripheral edge of said hollow cylindrical body and a lower open end defining a lower peripheral cutting edge including a plurality of teeth extending from said lower peripheral edge; a drive shaft having a diameter less than said cutting head, said drive shaft including a proximal end connecting to said end plate and having an opposing distal drive end extending therefrom; and a pilot drill extending from an end plate, said pilot drill disposed within said cylindrical hollow cutting head and extending in axial alignment with said drive shaft; said pilot drill extending pass said teeth extending from said lower peripheral edge of said cutting head; and a cutaway portion of the body extending around the periphery thereof a selected length forming an opening extending along a portion of said sidewalls extending from along a portion of the bottom above said teeth to said end plates, said cutaway portion forming a side cutting edge.”

Therefore, in respect to above discussions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of claims 1-19 of '413 Patent as a general teachings for an auger apparatus as claimed by the present application. The instant claims obviously encompass the claimed invention of '413 Patent and differ only in

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terminology. To the extent that the instant claims are broaden and therefore generic to the claimed invention of '413 Patent [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been claimed in a co-pending application.

12. Claims 2, 18, 28 and 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,129,163 in view of Morse. The teachings of Morse have been discussed above.

The '163 Patent discloses all of the features claimed in claims 2 and 28 except a cutaway portion having an opening to the side wall of the tubular body.

Morse discloses a core drill comprising of: a cylindrical hollow cutting head comprising a hollow cylindrical body (25) defining side walls connecting a top end defining an upper peripheral edge and a lower open end defining a lower peripheral cutting edge including a plurality of teeth (28) extending from the lower peripheral edge the hollow cylindrical body including a cutaway portion/openings (25) on the side wall and extending around the periphery thereof a selected length forming a side wall edge extending along the cutaway portion as discussed in paragraph no. 6.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the cutaway portion to the side wall of the '163 Patent's cylindrical body in order to efficiently remove the plugged core while in use.

*Allowable Subject Matter*

13. Claims 7, 8, 12-15, 17, 19 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims upon timely filing Terminal Disclaimer.

14. Claims 25 would be allowable over the prior art of record upon timely filing Terminal Disclaimer.

*Conclusion*

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Other references discloses an annular tool for cutting holes in metal, a hole saw with particle-aspirating accessory and a core drill.


16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jong-Suk (James) Lee whose telephone number is (703) 308-6777. The examiner can normally be reached on 6:30 am to 3:00 pm, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather C. Shackelford, can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Lee /jjl  
March 11, 2005



**Jong-Suk (James) Lee**  
**Primary Examiner**  
**Art Unit 3673**